

**SUBJECT: DECISION ON TERMINAL DISCLAIMERS INFORMAL FORM**

DATE: 3-14-00

APPL. S.N.: 081 986, 186

TO EXAMINER: T. Brusca

ART UNIT: 1436

**M. MINTGOMERY ROOM/LE18**

MAILROOM DATE 2-10-00

AFTER FINAL YES ☐ NO ☒ NUMBER OF T.D(S). FILED 1

**INSTRUCTIONS:** I have reviewed the submitted T.D. with the results as set forth below. If you agree, please use the appropriate form paragraphs identified by this informal memo in your next office action to notify applicant about the T.D. If you disagree with my analysis or have questions at all about the acceptability of the T.D., please see me or our Special Program Examiner. THIS MEMO IS AN INFORMAL, INTERNAL MEMO ONLY. IT MUST NOT BE MAILED TO APPLICANT, NOR SHOULD A COPY BE LEFT IN FILE.

☒ The T.D. is PROPER and has been recorded. (See 14.23).

☐ The T.D. is NOT PROPER and has not been accepted for the reason(s) checked below. (See 14.24).

☐ The recording fee of \$ \_\_\_\_\_ has not been submitted nor is there any pre authorization in the application file to charge to a deposit account. (See 14.26.07)

☐ Application Examiner has not processed T.D. fee. (See fee authorization).

☐ The T.D. does not satisfy Rule 321(b)(3) in that the person who has signed the T.D. has not stated his/her interest (and/or the extent of the interest of the business entity represented by the signature) in the application/patent. (See 14.26 and 14.26.01).

☐ The T.D. lacks the enforceable only during the common ownership clause needed to overcome a double patenting rejection, Rule 321(c). (See 14.27, 14.27.01).

☐ It is directed to a particular claims(s), which is not acceptable since "the disclaimer must be of a terminal portion of the term of the entire patent to be granted". MPEP 1490. (See 14.26, 14.26.02).

☐ The person who signed the terminal disclaimer:

☐ has failed to state his/her capacity to sign for the business entity, (See 14.28).

☐ is not recognized as an officer of the assignee, (See 14.29 and possibly 14.29.01).

☐ No documentary evidence of a chain of title from the original inventor(s) to assignee has been submitted, nor is the reel and frame specified as to where such evidence is recorded in the office. 37 CFR 3.73(b). (See 1140 O.G. 72). **NOTE:** This documentary evidence or the specifying of the reel and frame may be found in the T.D. or in a separate paper submitted by applicant. (See 14.30).

☐ No "statement" specifying that the evidentiary documents have been reviewed and that, to the best of the assignee's knowledge and belief the title is in the assignee seeking to take action. 37 CFR 3.73(b). (See 1140 O.G. 72) (See 14.31).

☐ The T.D. is not signed. (See 14.26, 14.26.3). or 14.26.03 if TD is not signed by all the owners.

☐ Attorney not of record in oath/decl. or a separate paper filed appointing a new or associate attorney. (See 14.29.01).

☐ The serial number of the application (or the number of the patent) which forms the basis for the double patenting is missing or incorrect. (See 14.32).

☐ The serial number of this application (or the number of the patent in reexam or reissue case(s) being disclaimed is missing or incorrect. (See 14.26, 14.26.04 or 14.26.05).

☐ The period disclaimed is incorrect or not specified. (See 14.27, 14.27.2 or 14.27.3)(For Samples 14.27.04 and 14.27.05)

☐ Other: \_\_\_\_\_

☐ Suggestion to request refund of \$ \_\_\_\_\_. (See 14.35, 14.36).

☐ **EXAMINER NOTE: IF APPLICATION IS IN CONDITION FOR ALLOWANCE ANY OF THE ABOVE INFORMALTIES MAY BE FAXED IN TO THE GROUP**

**FOR SAMPLE TERMINAL DISCLAIMERS AND CERTIFICATES:**

- ☐ Sample of a TD over a pending application and assignee Certificate (See 14.37).
- ☐ Sample of a TD over a prior patent and assignee Certificate (See 14.38).
- ☐ Sample Assignee Certificate under 37 CFR 3.73 (b) (See 14.39)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Application of: Peterson et al.

Serial No.: CPA of 08/986,186

Group Art Unit: 1636

Filed: December 5, 1997

Examiner: J. Brusca

For: METHODS FOR GENERATING AND SCREENING NOVEL METABOLIC PATHWAYS Atty Docket No.: 8757-009-999

**TRANSMITTAL OF TERMINAL DISCLAIMER AND FEE**

Assistant Commissioner for Patents  
Washington, DC 20231

Sir:

In response to the Office Action dated August 10, 1999, attorneys for Applicants submit herewith a Terminal Disclaimer on behalf of the Assignee of the above-identified application.

The fee for processing the attached Terminal Disclaimer Under 37 C.F.R. § 1.20(d) is estimated to be \$55.00 (small entity). Please charge the required fee to Pennie & Edmonds LLP Deposit Account No. 16-1150. A copy of this sheet is attached for accounting purposes.

Respectfully submitted,

Date: February 10, 2000

*Laura A. Coruzzi* By: *J. Christy* 40,258  
Laura A. Coruzzi 30,742  
(Reg. No.)

02/15/2000 VVAN11 00000006 161150 08986186  
01 FC:248 55.00 CH

**PENNIE & EDMONDS LLP**  
1155 Avenue of the Americas  
New York, NY 10036-2711  
(212) 790-9090

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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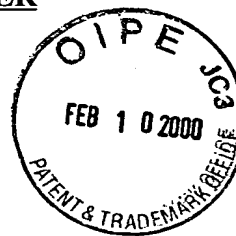
Examiner: J. Brusca

For: METHODS FOR GENERATING AND SCREENING NOVEL METABOLIC PATHWAYS  
Atty Docket No.: 8757-009-999

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TERMINAL DISCLAIMER

Assistant Commissioner for Patents  
Washington, D.C. 20231



Sir:

The petitioner, Mario Thomas, represents that he holds the position of President and Chief Executive Officer of TerraGen Discovery Inc. having a business address at 9880 Campus Point Drive, San Diego, California 92121, the assignee of the entire right, title and interest in and to the above identified application by virtue of an assignment by ChromaXome Corporation to TerraGen Discovery Inc. executed on March 16, 1999.

The petitioner hereby disclaims the terminal part of any patent granted on the above identified application which would extend beyond the expiration date of U.S. Patent No. 5,783,431 which was issued on July 21, 1998 and hereby agrees that any patent so granted on the above identified application shall be enforceable only for and during such period that the legal title to said patent shall be the same as the legal title to U.S. Patent No. 5,783,431.

The petitioner hereby disclaims the terminal part of any patent granted on the above identified application which would extend beyond the expiration date of U.S. Patent No. 5,824,485 which was issued on October 20, 1998 and hereby agrees that any patent so granted on the above identified application shall be enforceable only for and during such period that the legal title to said patent shall be the same as the legal title to U.S. Patent No. 5,824,485.

The petitioner further agrees that this agreement is to run with any patent granted on the above identified application and is to be binding upon the grantee, its successors, and assigns.

The petitioner does not disclaim any terminal part of any patent granted on the above-identified application prior to the expiration date of the full statutory term of U.S. Patent Nos. 5,783,431 or 5,824,485 in the event that either or both patent later expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. 1.321(a), has all claims canceled by a reexamination certificate, or is otherwise terminated prior to the expiration of its full statutory term, except for the separation of legal title stated above.

The petitioner hereby confirms that he has reviewed the assignment and, to the best of his knowledge and belief, title is in the assignee seeking to take action in this matter and that he is empowered to act on behalf of TerraGen Discovery Inc.

The petitioner hereby declares that all statements made herein of his own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Signed this 2<sup>nd</sup> day of February, 2000.

TerraGen Discovery Inc.

By: 

Name: Mario Thomas, Ph.D.

Position: President and Chief Executive Officer